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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,185	07/15/2003	Hirobumi Toyoda	3022-15	4961

20457 7590 09/11/2006

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EXAMINER	
CROSS, ALAN	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/619,185	TOYODA, HIROBUMI	
	Examiner	Art Unit	
	Alan Cross	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/7/06,1/19/05,*12/16/03
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2,4,5,6,8 of copending Application No. 10619183. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications disclose a gaming machine with a virtual player presented that controlled by the player input and responses to the game.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention should produce a useful,concrete and tangible result. A program not on a physical medium, which provides the functional descriptive material in useable form to permit the functionality to be realized with a computer, cannot produce a concrete and tangible result. The claim needs to include a program on a physical medium executed by a computer or device to be a patentable subject matter. Cf. In re Warmerdam.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4,6-9,15-19 rejected under 35 U.S.C. 102(e) as being anticipated by Miyamoto et al. (US Patent #6607443).

Regarding claims 1,6,11,15,16: Miyamoto discloses a gaming machine comprising: a display means for displaying a state of a game (col. 1, 60-67); and a game control means for controlling the state of the game in accordance with information input by a player; wherein a plurality of players including at least one virtual player who is not a real player play the game against each other (col. 1, 36-43), (col. 7, 3-7), the gaming machine comprising: an image data storage means for storing image data to be displayed on said display means as an image of the virtual player (col. 5, 32-67); and a response image data storage means for storing response image data, the response image data being provided individually according to each virtual player and displayed as images on said display means in association with expressions exhibited in accordance with a circumstance of the game being played with the gaming machine; wherein said game control means causes the response image data to be reproduced in accordance with the circumstance of the game played with the gaming machine (col. 2, 1-17). Miyamoto discloses a program being executed with a gaming machine (col. 2, 11-19).

Regarding claims 2,7,17: Miyamoto discloses the gaming machine according to claim 1, further comprising: an audio output means for providing audio output in accordance with the circumstance of the game (col. 4, 56-59); and a response audio data storage means for storing response audio data in association with a plurality of expressions exhibited in accordance with the circumstance of the game, the audio data comprising a plurality of response audio data of each virtual player, the audio data being output as a voice of the virtual player with said audio output means; wherein said game control means causes the response audio data to be reproduced in association with an

expression exhibited in accordance with the circumstance of the game played with the gaming machine (col. 5, 1-10, 22-26), (col. 6, 23-36).

Regarding claims 3,8,18: Miyamoto discloses the gaming machine according to claim 2, further comprising a data changing means for changing the response image data and/or the response audio data in accordance with a game playing history information of the virtual player, and/or fortune information of the virtual player (col. 9, 54-60).

Regarding claims 4,9,19: Miyamoto discloses the gaming machine according to claim 1, wherein said display means is installed individually for each player playing the game with said gaming machine (Fig. 1, #10, col. 2, 26-30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5,10,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto in view of Yamashita et al. (US Patent #6755743). Miyamoto teaches the gaming machine according to claim 1, except further comprising a message information sending means, with which a first player among the plurality of players sends message information to a second player among the plurality of players; and a message information receiving means, with which the second player receives the message information from the first player. Yamashita teaches a message information sending means, with which a first player among the plurality of players sends message information to a second player among the plurality of players; and a message information receiving means, with which the second player receives the message information from the first player (col. 2, 25-50). It would have been obvious to one of ordinary skill in the art to modify the invention of Miyamoto with the messaging means of Yamashita. This would allow users to have comradery and communicate any topics or strategize with each other.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto as applied to claim 1,6,11,15,16 above, and further in view of Haste III (US Patent #6273820).

Regarding claim 11: Miyamoto teaches a display means for displaying a state of a game; and a game control means for controlling the state of the game in accordance with information input by a player; wherein a plurality of players including at least one virtual player who is not a real player play the game against each other, the server comprising; an image data storage means for storing image data to be displayed on

said display means as an image of the virtual player; and a response image data storage means for storing response image data, the response image data being provided individually according to each virtual player and displayed as images on said display means in association with expressions exhibited in accordance with a circumstance of the game being played with the each gaming machine; wherein said game control means causes the response image data to be displayed on said display means, the response image data being stored by said response image data storage. As taught in claim 1, except a server controlling gaming machines via a communication line, each gaming machine. Haste teaches a server controlling gaming machines via a communication line, each gaming machine (col. 1, 40-46), (col. 2, 15-22). It would have been obvious to one of ordinary skill in the art to modify Miyamoto to be controlled by servers over a communication line using the teaching of Haste. This would allow a casino to monitor the game play and allow users across great distances to participate in a game together.

Regarding claim 12: The combination of Miyamoto and Haste teach the server according to claim 11, wherein the each gaming machine further comprises an audio output means for providing sound or voice in accordance with the circumstance of the game (col. 4, 56-59 Miyamoto), the server comprising: a response audio data storage means for storing response audio data of each virtual player in association with a plurality of expressions exhibited in accordance with the circumstance of the game, the audio data comprising the plurality of response audio data of each virtual player, the audio data being output as a voice of the virtual player with said audio output means;

wherein said game control means causes the response audio data to be reproduced in association with an expression exhibited in accordance with the circumstance of the game played with the each gaming machine (col. 5, 1-10, 22-26), (col. 6, 23-36).

Regarding claim 13: The combination of Miyamoto and Haste teach the server according to claim 12, further comprising: a game playing history storage means for storing game playing history information of each virtual player in association with each virtual player; and a data changing means for changing association between image data of each virtual player and the plurality of expressions exhibited in accordance with the circumstance of the game in accordance with the game playing history information (col. 9, 54-60)(col. 2, 18-32) Miyamoto.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto and Haste III as applied to claim 11,13 above, and further in view of Yamashita et al. The combination of Miyamoto and Haste teach the server according to claim 13, except each of the gaming machines comprising a message information sending/receiving means, with which a plurality of real players send and receive message information among each other, wherein the server comprises a communication control means for controlling communication among the gaming machines. Yamashita teaches each of the gaming machines comprising a message information sending/receiving means, with which a plurality of real players send and receive message information among each other, wherein the server comprises a communication control means for controlling communication among the gaming

machines (col. 2, 25-50). It would have been obvious to one of ordinary skill in the art to modify Miyamoto and Haste to have the messaging means and control of Yamashita. This would allow users to have comradery and communicate any topics or strategize with each other.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dote (US Patent #5221083) discloses a game with a virtual player that reacts to the game play.

Schneider et al. (US Pub #2003/0078101) discloses a player specific game system that is tailored to the user

Oh (US Patent #5616078) discloses a video machine that responds to the user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cross whose telephone number is 571-272-5529. The examiner can normally be reached on 8-4 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ARC 571-272-5529

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TC3700